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EXAMINER

ABDELSALAM, FATHI K

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1. The following is a final office action in response to communications received on 7/07/2009.

Response to Amendments

2. The amendment of 7/07/2009 has been received and entered. Claims 1 and 28 have been amended. Claims 1, 7, 8, 10, 12, 16 and 18-31 are pending herein.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1, 7, 8, 10, 12, 16, and 18-27 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the

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method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps, fail the first prong of the new Federal Circuit decision since they are not tied to another statutory class and can be performed without the use of a particular apparatus. Thus, claims 1, 7, 8, 10, 12, 16 and 18-27 do not positively recite another statutory class to which the method steps are tied and therefore are non-statutory.

Independent claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter) because claim 1 is directed to "an architecture designed to a platform...across two or more enterprise base system servers," which appears to be software *per se*, and therefore considered disembodied functional descriptive material. A computer software application *per se* does not define any structural and functional interrelationships between the computer application and other claimed elements of a computer which permit the computer application's functionality to be realized.

According the The American Heritage Dictionary of the English Language, a "server" can be a computer *or* program. Thus, the server recited herein falls under the category of "program," i.e. software *per se*, and is therefore non-statutory.

Furthermore, applicant's patent application publication confirms: "Embodiments of the invention can be implemented in a computing system that includes a back-end

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component, e.g., as a data server, or that includes a middleware component, e.g., an application server" [0062]).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 7, 10, 16, 18-25, and 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanches (US PG PUB 2003/0018510), in view of Freitag (US Patent 7069192).

7. Regarding **Claim 1**:

Sanches discloses a method of facilitating enterprise change comprising:

Generating, via an architecture designed to a platform,

a single logical information system across two or more enterprise base system servers connected to at least one database through base system connectors to execute pre-change due diligence and post-change integration of the enterprise change, wherein the enterprise change is at least one of a merger and acquisition ("One exemplary use of MECA is the integration of mergers and acquisitions" [0062]); See also ("In one embodiment, the MECA action management platform is a hosted extranet and computer telephony application. A client's MECA implementation runs on a

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collection of industrial database, application, and telephony servers in an ultra-secure data center" [0191]);

Identifying a synergy via the single logical information system ("MECA enables management to achieve more revenue and cost synergy targets" [0037]). See also ("The present invention manages the deployment, execution, and tracking of initiatives. "Initiatives" means coordinated non-routine efforts of large number of individuals and entities (up to many thousands or even more), for example, in an extended organization. Examples include, without limitation, regulatory compliance initiative, institution of new policies or practices, retraining projects, product launches, mergers and acquisitions" [0030]);

Conducting the synergy via a graphical user interface ("MECA, in one embodiment of the present invention, is an integrated, Web-based platform designed to manage all facets of initiative execution. Executive teams can simultaneously manage any number of critical initiatives, of any size. Via MECA's easy-to-use Web interface, users create, browse and manage action plans, team structures, and reports" [0055]);

creating at least one comparison of the synergy against a synergy target for the synergy by measuring the synergy against the synergy target ("Auto-calculate and compare actual performance to strategic objective targets" [0047]).

But, Sanches does not explicitly disclose the method capturing a history of changes. However, Freitag teaches: capturing a history of the enterprise change and applying the history to at least one subsequent enterprise change to achieve a subsequent synergy in the at least one subsequent enterprise change ("generates

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collaboration logs 7 as shown in FIG. 4. These contain such information as the name of the person making the changes, the date and time of the change, a status indicating if all members of the session agreed on the change, the location of the person making the change, a description of the method used to perform the change, a complete description of all parameters to be applied to the method used to perform the design change” [col. 7, line 34]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Sanches so as to have included change-log functionality, as taught by Freitag, in order to provide for an up to date synergy based on histories, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

In **KSR**, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of a method of facilitating enterprise change disclosed by Sanches and history of change-logs disclosed by Freitag would yield a predictable result, specifically a method of synergistic change including the use of historical change logs. It would have been obvious to one of ordinary skill in the art to modify Sanches’ method to include said log

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functionality of Freitag because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

8. Regarding **Claim 7**:

Sanches discloses the method of claim 1, wherein the graphical user interface further comprises:

a scale of measurement for the synergy, and ("MECA is used when the value of compliance can be at least roughly quantified, and where compliance in the action is potentially as important to the organization as compliance with other mandatory systems for financial reporting, HR and account management" [0155]). See also ("In preparing MECA for action, in one embodiment, managers use MECA Web interface to define: team structures; action plans (can also import from MS Project or other project planning tool); notifications and key communications; interactive action items; performance metrics and other business rules" [0059]). See also, ("As the strategic benefit, MECA maximizes and accelerates returns from strategic initiatives. In post-merger integration, for example, MECA enables management to achieve more revenue and cost synergy targets, and to achieve them more rapidly, predictably, and completely" [0037]); and

a selector for approval of the synergy (“TaskState.ACTIVE (meaning that the task is ready to be started or has started and is accepting fulfillments)” [0297]). See also (“task 210 he may accept or reject” [0320]).

9. Regarding **Claim 10**:

Sanches discloses the method of claim 1, wherein the graphical user interface further comprises:

a panel adapted to present merger-related views (“Manage data. View real-time reports on status, progress, outcomes Auto-calculate and compare actual performance to strategic objective targets” [0047]).

10. Regarding **Claim 16**:

Sanches discloses the method of claim 1, further comprising:

Conducting at least one of an approval action, a rejection action (“task 210 he may accept or reject” [0320]). See also (“generating an action plan including action items to accomplish the initiative tasks” [Abstract]);

a cancellation action (“As roles change, MECA automatically initiates, cancels or retargets action items and communications” [0058]); and

a storing action via an action interface (“an action management database for storing a dynamically generated organizational model” [0011]). See Also (“MECA, in one embodiment of the present invention, is an integrated, Web-based platform designed to manage all facets of initiative execution. Executive teams can

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simultaneously manage any number of critical initiatives, of any size. Via MECA's easy-to-use Web interface, users create, browse and manage action plans, team structures, and reports" [0055]).

11. Regarding **Claims 18**:

Sanches discloses the method of claim 1 wherein the graphical user interface further comprises:

Conducting at least one of a sales integration ("In post-merger integration, for example, MECA enables management to achieve more revenue and cost synergy targets, and to achieve them more rapidly, predictably, and completely" [0037]);

an account transition ("Implement hundreds of procedural changes and dozens of IT transitions" [0265]), file sharing, and

discussions ("Use MECA to centrally capture and communicate strategic objectives" [0039]). See also ("Manage task communication & delivery. Use MECA's form-builder to quickly create closed-loop mass communications and interactive "mass action items" that are embedded directly in transition plans" [0042]);

via an integration interface, and wherein integration interface features include at least one of a checklist for integration issues, and a panel for generating a document request ("MECA's easy-to-use Web interface, users create, browse and manage action plans, team structures, and reports" [0055]).

12. Regarding **Claim 19**:

Sanches discloses the method of claim 18 wherein the integration interface includes features for viewing at least one of deliverables ([0037], "MECA enables management to achieve more revenue and cost synergy targets [i.e. deliverables] "), and calendars ([0208], "Action management teams 20 may typically be composed of: (1) Action directors (AD) who define an action in business terms: desired outcomes, time-frames [calendar]").

13. Regarding **Claim 20**:

Sanches discloses the method of claim 1 wherein the synergy is at least one of a value, performance, and effect that can be achieved wherein resources of at least two enterprises combined will be greater than a sum of the resources of the at least two enterprises individually ("In one embodiment, the present invention provides MECA (Managed Enterprise Communications Command and Control Architecture), implemented by a hosted software tool that allows management to direct and measure the success of acquisitions and other high value, large scale initiatives" [0033]).

14. Regarding **Claim 21**:

Sanches discloses the method of claim 1 wherein the synergy is based on, at least in part, at least one of: a human resources group, one or more customers, one or more suppliers, one or more sales, one or more services, one or more organizational departments, one or more information technology issues, and one or more budgets ("An acquiring company's post-merger strategy may include consolidating all process,

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objectives, resources, and responsibilities of the two organizations: Processes. Sales practices, customer service standards, fulfillment and delivery methods, IT system operating procedures, engineering methodologies, human resource policies and procedures” [0161-0162])

15. Regarding **Claim 22**:

Sanches discloses the method of claim 1 wherein the synergy further comprises: achieving business goals (“MECA enables management to achieve more revenue and cost synergy targets” [0037]). See also (“ingredients of acquisition success are rapid integration of the acquired company, and universal understanding and buy-in of strategic objectives. The MECA action management platform is tailor-made to achieve both objectives” [0159]); and

assisting customers during the enterprise change (“action design (or planning) assistance” [0200]). See also (“When interacting with MECA via telephone auto-attendant, participants may enter a key such as “0” to connect to an Action Support Team 40 member for live assistance” [0229]).

16. Regarding **Claim 23**:

Sanches discloses the method of claim 1 wherein the subsequent synergy in the at least one subsequent enterprise change is achieved using a closed-loop feedback (“Real-time feedback on progress, compliance rates, and outcomes allows management to make mid-course corrections to keep the initiative on track” [0036]). See also (“For an

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urgent or key action item, rather than send repeated e-mail messages, the notification sequence may escalate to a phone call (i.e., a different communication media is used) from a support team 40 member” [0221])—the phone call representing a closed-loop feedback. See also (“Therefore, there is a need to close the loops between a relatively small number of managers and an arbitrarily large number of participants in the initiative” [0094])

17. Regarding **Claim 24**:

Sanches discloses the method of claim 23, along with making comparisons for synergistic objectives (“Auto-calculate and compare actual performance to strategic objective targets” [0047]).

But, Sanches does not explicitly disclose the method relaying a comparison from a history of changes. However, Freitag teaches a method wherein the closed-loop feedback further comprises:

relaying the at least one comparison from the history to a subsequent graphical user interface associated with the subsequent synergy in the at least one subsequent enterprise change; and applying the at least one comparison to the at least one subsequent graphical user interface to achieve the at least one subsequent enterprise change (“generates collaboration logs 7 as shown in FIG. 4. These contain such information as the name of the person making the changes, the date and time of the change, a status indicating if all members of the session agreed on the change, the location of the person making the change, a description of the method used to perform

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the change, a complete description of all parameters to be applied to the method used to perform the design change” [col. 7, line 34]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Sanches so as to have included change-log functionality, as taught by Freitag, in order to provide for an up to date synergy based on histories, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” In this case the combination of a method of facilitating enterprise change disclosed by Sanches and history of change-logs disclosed by Freitag would yield a predictable result, specifically a method of synergistic change including the use of historical change logs. It would have been obvious to one of ordinary skill in the art to modify Sanches’ method to include said log functionality of Freitag because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately. Furthermore one of ordinary skill in the art would have

recognized that the results of the combination were predictable, therefore the combination has been deemed obvious.

18. Regarding **Claim 25**:

Sanches discloses the method of claim 10 wherein the panel adapted to present merger related views further comprises at least one of:

a link to a file space view; a link to a methodology view; a link to a view of research; a link to a view of reports; and a link to a view of a merger log; See (“MECA dynamically links people, plans, & action performance in a single, Web-based, execution framework” [0049]) in conjunction with (“View real-time reports on status, progress, outcomes Auto-calculate and compare actual performance to strategic objective targets” [0047]).

19. Regarding **Claims 28-31**:

Claims 28, 29, 30, and 31 recite substantially similar limitations to claims 1, 20, 22, and 23, respectively, and are therefore rejected using the same art and rational set forth above.

Sanches further discloses a computer program product residing on a computer readable medium having a plurality of instructions stored thereon which, when executed by a processor, cause the processor to perform operations (“the present invention provides a computer readable medium having program code recorded thereon for

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planning and managing an initiative, the program code configured to cause a computing system to perform the following steps” [0010]).

20. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sanches (US PG PUB 2003/0018510), in view of Freitag (US Patent 7069192), and in further view of Minow et al. (US PG PUB 2003/0225652), hereinafter referred to as Minow. The references disclosing the functionality of Sanches and Freitag have been set forth above.

21. Regarding Claim 8:

Sanches discloses the method of claim 1, wherein the graphical user interface further comprises:

at least one synergy target (“MECA enables management to achieve more revenue and cost synergy targets” [0037]);

at least one sub-deliverable (“adjusting the timing, sequence, or targeting of individual or collective tasks based on those outcomes” [0031]).

But, Sanches does not explicitly disclose that the method accounts for at least one risk.

However, Minow teaches a system as above utilizing a risks section (“Board scores may be correlated with performance scores in the manner illustrated in Table 2, below, to arrive at overall, forward-looking, investment and risk-oriented letter grades” [0067]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system and method of Sanches so as to have included utilizing a risks section, as taught by Minow, in order to improve the efficiency of the system, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

22. Claim 12, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanches (US PG PUB 2003/0018510), in view of Freitag (US Patent 7069192), and in further view of Adhikari (US PG PUB 2004/0158479). The references disclosing the functionality of Sanches and Freitag have been set forth above.

23. Regarding Claims 12, 26, and 27:

Sanches discloses the method of claim 1; but, Sanches does not explicitly disclose the following elements that Adhikari discloses below:

Adhikari teaches:

a financial checklist interface adapted to present a financial checklist and wherein the financial checklist further comprises at least one of: a risk checklist item; a synergy checklist item; a list of legal data checklist item; a list of accounting data checklist item; and a list of internal data checklist items, wherein the internal data comprises proprietary information ("Enabled Advanced Features cells are marked with a square

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button with an "A" inside. Clicking the "A" icon associated with the following input data set element cells prompts the system to display new pop-up screens; Sales Growth and EBITDA Growth 116, EBITDA Synergy 120, Capital Expenditure 118, Accounts Receivable 96, Inventory 100, Accounts Payable 108, Additional Equity 206" [0088]); and

the financial checklist interface including at least one button configured to add or delete an item to or from the financial checklist and using the financial checklist to generate a synergy ("a square button with an "A" inside...EBITDA Synergy 120" [0088]).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Sanches so as to have included utilizing a financial checklist and an interface including a button, as taught by Adhikari, in order to improve upon the efficiency of the system, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Response to Arguments

24. Applicant's arguments filed 7/07/2009 have been fully considered but they are not persuasive.

25. Regarding the rejection of claims under 35 U.S.C. §103:

In regard to applicant's assertion that Sanches fails to teach "generating, via an architecture designed to a platform, a single logical information system across two or

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more enterprise base system servers,” Examiner respectfully disagrees. See (“In one embodiment, the MECA action management platform is a hosted extranet and computer telephony application. A client's MECA implementation runs on a collection of industrial database, application, and telephony servers in an ultra-secure data center” [0191]).

As regards applicant's assertion that Sanches also fails to disclose the limitation “identifying a synergy via the single logical information system,” Examiner, again, respectfully disagrees. See (“The present invention manages the deployment, execution, and tracking of initiatives. "Initiatives" means coordinated non-routine efforts of large number of individuals and entities (up to many thousands or even more), for example, in an extended organization. Examples include, without limitation, regulatory compliance initiative, institution of new policies or practices, retraining projects, product launches, mergers and acquisitions” [0030]); Examiner interprets the joint initiatives to be the identified synergies.

Lastly, with regard to applicant's assertion that Freitag's disclosed history-log of changes made is unanalogous in respect to applicant's limitation of “capturing a history of the enterprise change,” Examiner respectfully disagrees. Applicant's position rests on the assertion that “CAD changes and enterprise changes are not similar,” however, the mere nature of the intended use of a change-log will not solely distinguish the claims as patentable over the prior art.

Conclusion

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26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fathi Abdelsalam whose telephone number is (571) 270-3517. The examiner can normally be reached on Monday to Thursday 8:00-5:00pm ET.

28. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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29. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. A./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/

Primary Examiner, Art Unit 3689